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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,812	09/22/1999	PAUL M. MCELFRESH	304-15027-US	3837

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EXAMINER	
TUCKER, PHILIP C	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/400,812	MCELFRESH ET AL.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,7 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,7 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 4, 7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants claim 1 is amended to have an upper level for the R group of 274 carbon atoms, which is believed to be a typographical error. Applicants arguments seem to indicate that an upper level of 27 was meant to be claimed. However this introduces new matter, since applicants specification as filed limited the upper level of R to 24 carbon atoms.

Applicant's teaching of R' as being hydrogen in the formula is not supported in the specification, and adds new matter. Applicants specification only taught one compound TAPAO which included R' as hydrogen, which cannot be extrapolated to the several other compounds within the scope of formula (I).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, 7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Farmer (6239183).

Farmer teaches viscoelastic fluids which comprise a nonionic amine oxide, which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). The fluids may contain various salts, solids and cellulose materials which would inherently provide fluid loss control (column 2, line 64 – column 3, line 7 and column 4, lines 10-20). The breaking of the gelled fluid by formation conditions, or a breaker such as an oxidizer or acid is disclosed (see column 7, lines 24-30). The limitations of applicant's method are thus met by Farmer.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer (6239183).

Farmer teaches viscoelastic fluids which comprise a nonionic amine oxide, which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). The fluids may contain various salts, solids and cellulose materials which would obviously provide fluid loss control (column 2, line 64 – column 3, line 7 and column 4, lines 10-20). The breaking of the gelled fluid by formation conditions, or a breaker such as an oxidizer or acid is disclosed (see column 7, lines 24-30). Farmer differs from the present invention in not specifically teaching the use of tallow amidopropyl amine oxide as an amine oxide useful in the invention. Farmer however teaches the use of Tallow amidopropyl dimethylamine oxide in the drilling and treating fluids (example 8), which differs from the compound of claim 6 in having methyl groups instead of hydrogen atoms on the amine. As homologues with such similar structures would be expected to have similar properties and utility, it would be obvious to one of ordinary skill in the art to utilize homologues of the amine oxides disclosed by Farmer, including the tallow amidopropyl amine oxide of the present invention, in the fluids of Farmer, since such homologues would be expected to be useful in the the viscoelastic fluids of Farmer for drilling and fracturing (Ex parte Faque 121 USPQ 425).

7. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being obvious over Farmer (US 6239183).

The applied reference has a common asignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2). Applicants have stated that the present application is assigned to the same entity as US 6239183, as such the rejection under 35 USC 103(a) may be overcome according to the above rules.

8. Since the scope of the applied references were the same, the rejection rejection over the WO reference is dropped. Applicants arguments have been considered but are not deemed persuasive. Although applicants inadvertently failed to define R' as including hydrogen, the general formula did not define hydrogen as part of the R' group and as such adds new matter. The single disclosed compound TAPAO cannot support

the whole generic formula of claim 1 having hydrogen atoms as R' substituents. Similarly, applicants specification does not teach or suggest R having 27 carbon atoms (274 actually listed) in the formula. Contrary to applicants assertion, the salts, particles and cellulose used in the fluids of Farmer, would inherently or obviously provide fluid loss control to the fluids taught therein. The breaking of the gel is also specifically taught at column 7, lines 24-30 of Farmer. The rejections are thus maintained.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2956